

REMARKS

Reconsideration of the above referenced application in view of the enclosed amendments and remarks is requested. Claims 1-20 remain pending without amendment. Claims 1, 6, 11, and 16 are the independent claims.

ARGUMENT

The Office Action objects to the drawings. The Office Action also includes claim rejections based on 35 U.S.C. § 103(a).

Objections to the Drawings

The Office Action objects to the use of reference number 106 on more than one feature in the drawings. A prior response amended Fig. 1 to respond to other objections. In the process of generating the replacement page for Fig. 1 in the previous response, a typographical error was made, which inadvertently changed the reference numeral for player function 126 to "106". Attached hereto in the Appendix is a replacement sheet for Fig. 1, showing that the player function has been properly re-labeled with reference numeral 126, as submitted in the original version of Fig. 1 filed with the Patent Application. Accordingly, the reference number for the player function in computer system 134 has been changed from 106 back to 126.

The Office Action also objects that reference numeral 114, relating to software as indicated in the 18th line of page 7, is not present in the drawings. Again, software 114 was inadvertently deleted from the original drawings when replacement drawings were previously submitted. Such oversight has been corrected in the replacement sheet attached hereto.

It has also come to the attention of Applicant that additional items were inadvertently deleted in the replacement sheet for Fig. 1 that was previously submitted. In particular, the attached replacement sheet for Fig. 1 includes the following elements that were present in the original version of Fig. 1, and were not

intended to be deleted in replacement drawings previously submitted: audio title 138 and audio content 118.

In addition, in the appended replacement sheet for Fig. 1, a second occurrence of reference numeral 136 has also been re-introduced into Fig. 1. This amendment, which was purportedly made in response to a previous objection to the drawings (reference numeral for audio file in computer system 134 was purportedly changed from 138 to 136), was not reflected in the previously-submitted replacement drawing for Fig. 1. It is reflected in the appended Replacement Sheet for Fig. 1.

None of the changes to the figures introduce new matter. All objected items have been corrected; Applicant requests that the replacement sheet for Fig. 1 be entered and that the objections be withdrawn.

35 U.S.C. § 103(a)

The Office Action rejects claims 1-2, 5-8, 10-12, 15-17, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application serial no. 09/737,486, publication no. US 2001/0027396 A1, by Tatsuhiko Sato (hereinafter "Sato"), in view of U.S Patent No. 5,675,708 to Fitzpatrick et al. (hereinafter "Fitzpatrick"). The Office Action further rejects claims 3-4, 9, 13-14 and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Fitzpatrick and in further view of U.S. patent no. 5,834,670 to Takeshi Yumura et al. (hereinafter "Yumura"). Applicant respectfully traverses those rejections, at least because 1) the Office Action has failed to make a prima facie showing of obviousness as to each and every limitation of the rejected claims and 2) the Office Action has failed to make a proper showing of a motivation to combine the cited references.

Regarding Claims 1, 11 and 16, Applicant traverses the assertion of the Office Action, that "[t]he synchronism between the playing of the audio file and audio data from the synthesizer reads on the concept of 'concatenating at least a portion of an audio format of the descriptive information'." Office Action, Page 4. Applicants respectfully assert that rendering of audio information from a synthesizer

is not concatenation. The Office Action has thus failed to make out a *prima facie* case of obviousness regarding Claims 1, 11 and 16. Such claims, as well as their dependent claims, are allowable for at least this reason. Each of these independent claims is further addressed separately below.

Claim 1. Regarding Claim 1, the Office Action admits that Sato does not specify “that the concatenating of the at least a portion of the audio format of the descriptive information is executed to an audio file.” (Office Action, p. 4). Applicants agree.

The Office Action attempts to remedy this deficiency in the *prima facie* showing of obviousness by relying on Fitzpatrick. However, such reliance must fail. The legal requirements for a *prima facie* case of obviousness are clear. “The Office Action bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP § 2142. The cited references must teach or suggest all the claim limitations in order for a *prima facie* case of obviousness to lie. MPEP § 2142 (emphasis added).

Neither Sato or Fitzpatrick, alone or in combination, discloses, suggests or teaches “concatenating at least a portion of an audio format of the descriptive information to the audio file”. (Claim 1, in part, emphasis added). Fitzpatrick discloses instead *translating or converting* a multimedia data stream or file to an audio media. See Fitzpatrick, Col. 3, lines 15-20. Specifically, the Fitzpatrick input file is an input file to be converted to audio media; it is initially “a file system file or a standard input device type of data stream file resulting from data input which contains multimedia information, a subset of which is audio.” The Fitzpatrick input file is not an audio file -- it may include video elements, graphical elements, document format control, etc. See Fitzpatrick, Col. 3, lines 61-65. Fitzpatrick thus takes a file of one type (not an audio file) and generates an output file of another type (an audio file).

Fitzpatrick simply does not, either alone or in combination with Sato, disclose, suggest, or teach “concatenating at least a portion of an audio format of the descriptive information to the audio file”. (Claim 1, in part). Indeed, Fitzpatrick

teaches away from such approach. That is, the problem that Fitzpatrick seeks to solve is the loss of non-discriminable data that the human ear cannot understand (such as video or graphics data) from a converted audio file. See Fitzpatrick, Col. 3, lines 57 – 61. If Fitzpatrick did, as the Office Action claims, teach “concatenating at least a portion of an audio format of the descriptive information to the audio file” such that the initial audio and metadata were contained in an input audio file, then no non-discriminable data would be present in such input file, and the motivation behind the Fitzpatrick disclosure would be obviated. Claim 1 is allowable for at least this reason. In addition, Claims 2-5, which depend from Claim 1, are also allowable for at least this reason.

Even if the cited references did, individually, disclose all elements of Claim 1 (which assertion Applicant vigorously disputes), a *prima facie* case of obviousness is not made out. The mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also **suggests** the desirability of the combination.

The Office Action argues that “[t]o one of ordinary skill in the art at the time the invention was made, it would have been obvious to perform the signal combination of Sato in the digital domain though [sic] a method such as the subsequent writing of entities as disclosed by Fitzpatrick.” The Office Action further claims that that the motivation behind such modification would have been that “such digital processing would have not required hardware capable of efficient processing for the real time production of output.” Office Action, p. 4. Applicant traverses these assertions.

There is absolutely no suggestion in either Sato or Fitzpatrick that “such digital processing would have not required hardware capable of efficient processing for the real time production of output” as a motivating factor to combine their teachings with each other. Fitzpatrick is directed toward a method for translating or converting multimedia data streams and files to and from audio media without loss of non-discriminable data so that the original multimedia data stream can be re-created after audio conversion. Fitzpatrick states that “[t]ranslation or conversion of

multimedia data to and from an audio media presents particular problems," particularly loss of information. See Fitzpatrick, Col. 1, lines 25-44. Fitzpatrick does not disclose, suggest or teach reduced hardware requirements as a motivating factor.

This motivating factor is also absent from Sato. Sato seeks to present text data to a user while the user is in a relaxed posture, without requiring the user to be in a posture such that s/he can see a display device. Indeed, Sato includes components (text information extraction unit, voice synthesizer, and controller) specifically directed to real-time production of audio output while the user is listening to music data. See Sato, p. 1, para. 11-14. Sato provides various embodiments, but none of the embodiments suggest, teach or disclose desirability of limiting real-time hardware components. The Office Action has thus failed to make out a *prima facie* case of obviousness at least because it has failed to make a proper showing of a motivation to combine the cited references.

"The level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP 2143.01, citing *AI-Site Corp. v. VSI Int'l Inl.*, 174 F. 3d 1308 (Fed. Cir. 1999). Instead, there must be some objective reason to modify the teaching of the reference. See MPEP § 2143.01 (argument that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness). The Office Action has failed to make such a showing. Claim 1 is thus allowable for at least this reason. In addition, Claims 2-5, which depend from Claim 1, are also allowable for at least this reason.

Claim 6. The Office Action relies on its arguments regarding Claim 1 in its rejection if Claim 6. Applicant traverses this approach because the elements of Claim 1 and Claim 6 are not identical. The cited references must teach or suggest all the claim limitations in order for a *prima facie* case of obviousness to lie. MPEP § 2142 (emphasis added). Accordingly, because it does not specifically address each limitation of Claim 6, the Office Action has failed to make a proper *prima facie*

showing of obviousness for Claim 6. Claim 6 is allowable for at least this reason. Also, Claims 7 – 10, which depend from Claim 6, are also allowable for at least this reason.

In addition, the Office Action has failed to make the proper showing, even with regard to those elements of Claim 6 which it specifically addressed. In particular, the Office Action asserts at p. 6 that Sato reads on the “concept of ‘mixing’.” First of all, Applicant respectfully reiterates that it is the exact claim language of Claim 6 that must be addressed, not a “concept.” Claim 6 recites “mixing an audio format of at least a portion of the descriptive information with the audio file.” A *prima facie* showing of obviousness regarding such quoted element has not been made out – Claim 6 is therefore allowable for at least this reason.

Secondly, Applicant does not agree that the limitation of “mixing an audio format of at least a portion of the descriptive information with the audio file” is met by the teaching of a delayed synchronism option in Sato. It is not “an audio *format* of at least a portion of the descriptive information” that is synchronized in Sato. Rather, Sato outputs a *rendering* of data information at a certain time after the start of the playing of an audio file. The Office Action asserts that Sato teaches “mixing in the digital domain.” However, Sato does not teach any such thing; as the Office Action admits, “the data from the synthesizer (23) is passed through a D/A converter before it is chronologically associated with the audio data of the audio file.” Office Action, p. 4. Accordingly, the Office Action has clearly failed to make a *prima facie* showing of obviousness regarding at least the following element of Claim 6: “mixing an audio format of at least a portion of the descriptive information with the audio file.” Claim 6 is allowable for at least this reason. Also, all claims that depend from Claim 6 are also allowable for at least this reason.

Finally, Applicants again point out that the Office Action has failed to make a proper showing of motivation to combine the Sato and Fitzpatrick references with respect to Claim 6. As is discussed above in connection with Claim 1, there is no objective teaching in either Sato nor Fitzpatrick to combine their teachings with each other for the purpose of “elimination of the requirement of components capable of

real time processing.” Office Action, p. 6. A prima facie case of obviousness thus has not been made out for Claim 6. Claim 6 is therefore allowable for at least this reason. In addition, Claims 7 – 10, which depend from Claim 6, are also allowable for at least this reason.

Claim 11. Claim 11 is allowable at least because the Office Action has failed to address each and every element of Claim 11 in its rejection. A prima facie showing of obviousness thus has not been properly made.

In addition, the Office Action has failed to make a prima facie showing of obviousness at least with respect to the following element of Claim 11: “concatenating at least a portion of an audio format of the descriptive information to the audio file.” See discussion of Claim 1, above. Claim 11 is allowable for at least these reasons. In addition, all claims that depend from Claim 11 are also allowable for at least these reasons.

Claim 16. Claim 16 is allowable at least because the Office Action has failed to address each and every element of Claim 16 in its rejection. A prima facie showing of obviousness thus has not been properly made.

In addition, the Office Action has failed to make a prima facie showing of obviousness at least with respect to the following element of Claim 16: “concatenating at least a portion of an audio format of the descriptive information to the audio file.” See discussion of Claim 1, above. Claim 16 is allowable for at least these reasons. In addition, all claims that depend from Claim 16 are also allowable for at least these reasons.

Claims 3-4, 9, 13-14, and 18-19. As is set forth above, neither Sato nor Fitzpatrick, either alone or in combination teach the recited elements of independent Claims 1, 6, 11, nor 16. Furthermore, the Office Action has failed to provide a proper showing of motivation to combine the Sato and Fitzpatrick references. Therefore, Claims 3-4, 9, 13-14, and 18-19, each of which depends from one of the independent claims discussed above, are all allowable.

For these and other reasons, claims 1, 6, 11, and 16 are allowable. Since the independent claims are allowable, dependent claims 2-5, 7-10, 12-15, and 17-20 are also allowable.

CONCLUSION

In view of the foregoing reasons and other reasons readily apparent, Claims 1-20 are all in condition for allowance. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 439-8778. Early issuance of Notice of Allowance is respectfully requested.

Respectfully submitted,

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Paul A. Mendonsa
Patent Attorney
Intel Americas, Inc.
Registration No. 42,879
(503) 439-8778

c/o Blakely, Sokoloff, Taylor &
Zafman, LLP
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026

Attachments: Replacement Sheet for Fig. 1

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